

(Practitioner's Docket No. 780-99-014-23973)

## REMARKS

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1. Rejection of claim 11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 11 has been rejected as being indefinite for using the term "bar".

Applicants respectfully request reconsideration in light of the amendment to claim 11.

Claim 11 has been amended to replace the word "bar" with the word "are". Claim 11 adds no new matter as the claim is supported by claim 11 as originally filed.

Reconsideration and removal of the rejection is respectfully requested in view of the foregoing amendment and remarks.

2. Rejection of claims 1, 2, 4-11 and 13-15 under 35 U.S.C. §103(a) as being unpatentable over Brownawell et al., U.S. 5,069,799, hereafter "Brownawell" or "'799"

The PTO states:

"Brownawell '799 discloses an oil filter comprising a hollow housing having an inlet and an outlet, a mechanically active filter member (i.e., "inactive filter media" 12) disposed inside the housing, and a chemically active filter member (i.e., 14) disposed inside this housing. This reference further discloses an embodiment (see Fig. 2) having a supplemental cartridge with a chemically active filter member (i.e., 30) disposed therein. The chemically active filter member includes a plurality of particles (see col. 2, line 6) containing a beneficial additive such as a basic salt of the type recited (see col. 2, lines 12-17). This reference further teaches that the chemically active filter media may include a polymeric binder (see col. 2, line 2).

(Office Action of 4/11/2006, pages 2- 3)

Applicants appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or

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in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2143*

However, as admitted by the PTO, Brownawell does not disclose the diameter of the particles in the chemically active filter member, the percentage of polymeric binder present, the percentage of basic salt in these particles, and the specific polymer binder employed (claims 2 and 14). Nonetheless, the PTO argues that it would have been "been obvious to one of ordinary skill in the art at the time the invention was made to employ particles having the recited diameter, polymeric binder content, and basic salt content in the reference system, in order to optimize the treatment capability of these particles."

Applicants respectfully disagree with this position. Specifically, Applicants respectfully submit that there is no teaching or suggestion in Brownawell of the specific filter claimed by Applicants' claim 1. In particular, there is no teaching or suggestion in Brownawell of a filter having pellets having a specific size range, and comprising a specific amount of a basic salt and a specific amount of binder.

The specific amount of binder and the specific particle size range required by independent claim 1 allows "hot oil [to] slowly [flow] past the basic conditioner in the chemically active filter, and the basic salt thereof [to act] to counteract and neutralize acidic combustion products." (paragraph 47 of Applicants' Specification.) Thus, Applicants' claimed particle size and binder content is specifically formulated to allow the controlled release of basic conditioner into the oil.

Further, the PTO states:

"Applicants should note that the particles in the particles in the Brownawell '799 device will inherently have some particle size, some percentage of polymer binder, and some percentage of basic salt." and "since the record does not show that Applicant is able to obtain a new and unexpected result from the recited combination of particle size, polymer binder percentage and basic salt percentage it would have been obvious to one of ordinary skill in the oil treatment art to select the recited values for these parameters in the system of Brownawell '799, in order to obtain results which are commensurate with such selected values."

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(Office Action of 4/11/2006, page 3, emphasis in original).

Applicants respectfully submit that Brownawell does not teach or suggest the claimed particle size of claim 1.

It is respectfully submitted that the PTO's statement that "particles ...must inherently have some average diameter" says **nothing** about the selection of particles within a relatively narrow range of 0.10-3 millimeters as disclosed in Applicants' claim 1. The PTO's position appears to be more analogous to an inherency based anticipation argument rather a prima facie case of obviousness per MPEP 2143.

Unlike anticipation, MPEP 2143 requires a *suggestion or teaching*. Per the requirements of MPEP 2143, the '799 reference cannot teach or suggest all of the required limitations of claim 1 without a suggestion to select particles having Applicants' narrowly selected average particle diameter size range.

Moreover, the conclusion of obviousness based on Brownawell made in the Office Action of 4/11/2006, could not have been made without the hindsight benefit of Applicants' teachings as to the importance of having flow paths between the particles comprising the basic salt, wherein the flow paths spaces result from the selection of particles having a specified average diameter. The CAFC has stated "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore & Assocs., Inc., v. Garlock*, 220 U.S.P.Q. 303, 312-313. (Fed. Clr. 1983).

Indeed, the PTO's statements as to the 'obviousness' of Applicants' required average particle diameter range ignore the express teachings of other Brownawell references. For example, U.S. Patent 5,252,081 to Brownawell teaches that active filter media suitable for use in making a solid hollow composite have sizes in the range of from 0.1 to 3000 *micrometers*. It is noted that the wide ranges of particle size used in the prior art will not create adequate flow paths in that smaller particles will inherently fill the flow path created by the larger particles.

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Indeed, those of skill in the art have often focused on providing greater surface area in order to provide greater surface contact. It will be appreciated that decreasing particle size leads to increasing surface area for contact with the incoming oil to be treated. Many of skill in the art would suggest that it would be obvious to select smaller particles to obtain greater surface area. Thus, the PTO's suggestion ignores the other problems and concerns of those of skill in the art and fails to provide a real motivation to do what Applicants have done.

In the absence of Applicants' teachings, one of skill in the art would have no motivation to select particles having the narrowly selected average diameter of from 0.1 to 3 millimeters.

This fact pattern is thus governed by the Federal Circuit's holding in *In re O'Farrell*. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q. 1673 (Fed. Cir. 1988).

It is respectfully also submitted that the PTO's suggested motivation for Applicants' required average particle diameters in Applicants' claim 1 is nothing more than an application of the prohibited 'obvious to try' standard. "Obvious to try" is not a valid test of patentability. *In re Mercier*, 185 U.S.P.Q. 774 (C.C.P.A. 1975). Patentability determinations based on that as a test are contrary to statute. *In re Antonie*, 195 U.S.P.Q. 6 (CCPA 1977).

As indicated by the '799 reference, there is a wide universe of particle sizes that could be utilized in an oil filter. It is pure speculation on the PTO's part that one of ordinary skill in the art would find it obvious to try and select Applicants' particular limited average diameter sizes in order to obtain Applicant's required flow paths. The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular structural modification is "well known" and thus obvious. *In re Wagner et al.* 152 U.S.P.Q. 552 (C.C.P.A. 1967).

The PTO's proposed rational to justify the many modifications necessary to obtain Applicants' claimed invention does not take the place of a suggestion in the prior

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art to make such modifications. There must be a teaching in the *prior art* for the proposed combination or modification to be proper. *In re Newell*, 13 U.S.P.Q.2d 1248 (Fed Cir. 1989), *emphasis added*. Even if the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed Cir. 1989).

Further, Applicants respectfully submit that Brownawell '799 does not teach or suggest the claimed basic salt concentration of claim 1.

As discussed in Applicants' Specification, Applicants use a solvent based method for forming particles which allows high concentrations of basic salts and low concentrations of binder (paragraph 53 of Applicants' Specification.)

However, the '799 reference does not use Applicants specific method for producing high salt concentration particles. Therefore, the '799 reference does not teach particles having the specific amount of basic salt and a specific amount of binder claimed in Applicants' independent claim 1.

The PTO continues to hold that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the recited amount of basic salt in the reference particles, in order to ensure that a sufficient amount of additive is present in these particles to adequately rejuvenate the oil under going treatment."

Further, the PTO states "Applicants should note that the particles in the chemically active filter member of Brownawell '799 must inherently have some percentage of basic salt." However, as noted above with respect to the PTO's argument of 'some diameter', a rational to justify a modification does not take the place of the suggestion in the prior art to make such a modification. There must be a teaching in the *prior art* for the proposed combination or modification to be proper. *In re Newell*, 13 U.S.P.Q.2d 1248 (Fed Cir. 1989), *emphasis added*. Even if the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed Cir. 1989).

Applicants respectfully submit that since Brownawell '799 does not teach Applicants' specific low solvent process for producing individual particles having high

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concentrations of additives, and one of ordinary skill in the art would not recognize the advantage of having high particle concentrations. Most importantly, Brownawell '799 is silent as to any need to have a concentration of basic salt concentration of 80%-97% based on the total pellet weight. Therefore, one of ordinary skill in the art would not read Brownawell to teach the required 90-97 percent concentration.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03. The required concentration of basic salt particles is not taught by the prior art.

Taken as a whole, it is respectfully submitted that the cited reference fails to provide a prima facie case of obviousness.

Reconsideration and removal of the obviousness rejection of claim 1, along with claims 1, 2, 4-11 and 13-15, which are dependant upon claim 1, is respectfully requested in view of the amendment and foregoing remarks.

3. Rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over Brownawell et al., U.S. 5,069,799, further in view of Bilski et al, U.S. 5,725,031, hereafter "Bilski" or "'031".

The PTO states:

"Brownawell '799 as modified above discloses the claimed invention with the exception of the recited location of the chemically active filter element was in respect to the mechanically active filter element. Bilski discloses a similar oil filter containing both a mechanically active filter element and means for adding a chemical to oil undergoing treatment, and further discloses (see Fig. 1) locating the chemical adding element radially and coaxially inside the mechanically active filter element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the chemically active filter element (i.e., 14) of Brownawell '799 inside the mechanically active filter element (i.e., 12), as suggested by Bilski, in order to produce a more compact filtration and treatment device."

(Office Action of 4/11/2006, page 4)

Applicants appreciate the detailed basis of rejection but must respectfully disagree.

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To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2143*

Independent claim 1 is nonobvious over Brownawell for reasons stated in section 1 herein incorporated by reference. Further, Bilski does not overcome any of the above noted deficiencies of Brownawell. Therefore, it is respectfully submitted that claim 3 is nonobvious over Brownawell in light of Bilski.

**4. Rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Brownawell et al., U.S. 5,069,799 and DeJovine, and further in view of Robers et al, U.S. 5,544,699, hereafter "Robers" or "'699".**

The PTO states:

"The modified primary reference discloses the claimed invention with the exception of the recited auxiliary inlet and outlet tubes. Robers discloses an oil filter having auxiliary inlet and outlet tubes (42 and 44), in order to cool the oil in the system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of the modified primary reference with the cooling arrangement of Robers, in order to obtain the advantages disclosed by this secondary reference for the system of the modified primary reference."

(Office Action of 4/11/2006, page 4)

Applicants appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2143*

Independent claim 1 is nonobvious over Brownawell for the reasons stated in section 1 herein incorporated by reference in its entirety. Further, the Undersigned is confused as to how the Examiner is using the DeJovine reference, as the Examiner cites DeJovine but then fails to show how DeJovine is being applied. Further, Rober does not overcome any of the above noted deficiencies of Brownawell. Therefore, it is respectfully submitted that since claim 12 is dependant on claim 1, claim 12 is nonobvious over Brownawell in light of Robers.

Therefore, reconsideration and removal of the obviousness rejection of claim 12 is respectfully requested in view of the foregoing amendments and remarks.

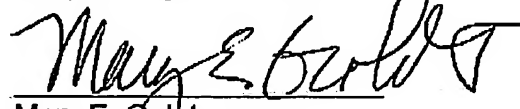


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**CONCLUSION**

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



Mary E. Golota  
Registration No. 36,814  
Cantor Colburn LLP  
(248) 524-2300

July 11, 2006